

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**APPEAL FROM THE EXAMINER TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Amir M. Saffarian
Serial No.: 08/828,022
Filing Date: March 27, 1997
Group Art Unit: 2876
Examiner: Jamara A. Franklin
Title: AUTOMATED SYSTEM AND METHOD FOR
CHECK AMOUNT ENCODING AT A POINT-OF-
SALE

BOARD OF APPEALS AND INTERFERENCES

Honorable Assistant Commissioner
for Patents

Washington, D.C. 20231

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Dear Sir:

APPEAL BRIEF

Appellant has appealed to this Board from the decision of the Examiner, contained in a final Office Action mailed March 13, 2001, finally rejecting Claims 19, 20, and 22-26. Appellant mailed a Notice of Appeal on May 9, 2001. Appellant respectfully submits this Appeal Brief, in triplicate, along with the statutory fee of \$310.00 under 37 C.F.R. § 1.17(c).

REAL PARTY IN INTEREST

The real party in interest for this Application under appeal is Electronic Data Systems Corporation.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant, the undersigned Attorney for Appellant, or the Assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 19, 20, and 22-26 were rejected in the final Office Action mailed March 12, 2001. Claims 19, 20, and 22-26 are all presented for appeal and are set forth in the Appendix hereto.

STATUS OF AMENDMENTS

All amendments submitted by Appellant were entered by the Examiner before the issuance of the final Office Action mailed March 13, 2001.

SUMMARY OF INVENTION

According to one embodiment of the present invention, a portable check encoding device (204) includes an input device (208) that receives a check amount from a user and a display (206) that is coupled to the input device (208) and that displays the check amount entered by the user. (Page 6, Line 33 to Page 7, Line 12; Page 7, Lines 27-34). The portable check encoding device (204) also includes a portable check printer (211) that is coupled to the input device (208) and that receives the check amount from the input device (208) and encodes the check amount in magnetic ink at a predetermined location on a check. (Page 8, Lines 1-33).

ISSUES

1. Whether Claims 19, 22 and 26 are patentable under 35 U.S.C. § 103(a) over *Foudos* (U.S. Patent Number 4,053,735) in view of *Clary* (U.S. Patent No. 5,187,351);
2. Whether Claims 20, 23, and 24 are patentable under 35 U.S.C. § 103(a) over *Foudos* and *Clary*, and further in view of *Yasui* (U.S. Patent Number 5,583,783); and
3. Whether Claim 25 is patentable under 35 U.S.C. § 103(a) over *Foudos* and *Clary*, and further in view of *Howard* (U.S. Patent Number 4,635,219).

GROUPING OF CLAIMS

Pursuant to 37 C.F.R. § 1.192(c)(7), Appellant requests that the following claims be grouped together for purposes of this appeal:

1. Group 1 - Claims 19, 22, and 26 may be deemed to stand or fall together for purposes of this appeal;
2. Group 2 - Claims 20, 23, and 24 may be deemed to stand or fall together for purposes of this appeal;
3. Group 3 - Claim 25.

These groupings are consistent with the three different grounds of rejection that Appellant is appealing.

ARGUMENTS

Issue 1: Rejection of Claims 19, 22, and 26

The Examiner rejected Claims 19, 22 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Foudos* (U.S. Patent Number 4,053,735) in view of *Clary* (U.S. Patent No. 5,187,351).

Foudos discloses a portable unit to which a bank may transfer user-expendable credit via a fixed unit. (Column 2, Lines 32-42). The user may enter an amount of a transaction into the device and select a cash or credit option. (Column 3, Lines 5-55). The user then inserts a check into the device and presses a print key successively to print each digit of the

transaction amount on the check. (Column 4, Lines 20-34). The check includes spaces for the user to enter the date, payee name, the user's signature, and the written transaction amount by hand. (Column 4, Lines 20-34, 57-64).

Independent Claim 19 recites the following limitations:

A portable check encoding device, comprising:
an input device operable to receive a check amount from a user;
a display coupled to the input device and operable to display the check amount entered by the user; and
a portable check printer coupled to the input device and operable to receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check.

Foudos does not disclose, teach, or suggest these features and operation, whether *Foudos* is considered alone or in combination with *Clary*, any other cited reference, or with the knowledge of one having ordinary skill in the art at the time the invention was made. As acknowledged by the Examiner, *Foudos* "fails to disclose that the encoded check amount is encoded in a machine-readable format at a predetermined location on the check." *Foudos* also does not disclose, teach, or suggest a check encoder that encodes a check amount on a check in magnetic ink, as recited by amended Claim 19. However, the Examiner asserts that "in view of *Clary*'s teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify *Foudos*' device so that it has the capability of encoding the check amount in a machine-readable format at a predetermined location on the check."

However, the Examiner has not cited language in either reference or within information commonly known to those skilled in the art to that provides the necessary motivation or suggestion to combine the two references. The device disclosed in *Foudos* has a primary purpose of issuing assured checks using bank credit disbursements to a portable unit, in conjunction with preventing fraudulent tampering with the portable unit. In fact, because the *Foudos* device provides for accounting of user-expendable credit with a bank, there is no need or motivation to print the check amount in a machine-readable format on the MICR line to expedite bank processing of the check at a later time. Furthermore, *Clary*

discloses a "back-office" check encoder that does not directly receive user input of a transaction amount. Moreover, *Clary* discloses that "MICR encoding machines are both too bulky and too expensive to be positioned at every teller station." Therefore, there is no suggestion to combine the check encoder of *Clary* with the other limitations of the portable check encoding device recited in Claim 19. In fact, *Clary* teaches away from such a combination. Appellant thus submits that the Examiner's reliance on the *Clary-Foudos* combination to reject claims 19, 22, and 26 is improper.

Furthermore, even if these references were properly combined, neither reference discloses, teaches, or suggests a portable check encoding device that includes a portable check printer that is operable to encode a check amount (received from a user input device) in magnetic ink at a predetermined location on a check. As recognized by the Examiner, *Foudos* does not disclose such a limitation. Furthermore, as described above, *Clary* discloses a "back-office" check encoder that does not directly receive user input of a transaction amount and also discloses that "MICR encoding machines are both too bulky and too expensive to be positioned at every teller station." Therefore, *Clary* does not disclose, teach, or suggest a portable check printer and actually teaches away from such a limitation. For at least these reasons, Appellant respectfully requests submits that Claim 19, together with the claims that depend from Claim 19, are patentable under 35 U.S.C. § 103(a).

Issue 2: Rejection of Claims 20, 23, and 24

The Examiner rejected Claims 20, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Foudos* and *Clary*, and further in view of *Yasui* (U.S. Patent Number 5,583,783). Appellant respectfully submits that there is no suggestion to combine the teachings of *Foudos*, *Clary* and *Yasui* to disclose a portable check encoding device that encodes a check amount in magnetic ink and that stores a list of payee names, that displays the payee names, or that prints a payee name in the payee field of a check. Neither *Foudos* nor *Clary* disclose, teach, or suggest that a payee name is printed on a check or that payee names are stored or displayed by a device. In fact, *Foudos* teaches away from such a limitation by disclosing that "spaces are designated for handwritten entry by the user of the . . . the payee's name". (Column 4, Lines 57-59). *Clary* also teaches away from such a limitation by illustrating checks including a handwritten payee name. (Figures 1 and 4).

Furthermore, *Yasui* does not disclose, teach, or suggest any portable device or a check printer that may encode a check amount on a check in magnetic ink. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). There is no such suggestion to combine *Foudos*, *Clary* and *Yasui*, and thus Appellant respectfully submits that the rejection of Claims 20, 23, and 24 is improper.

Furthermore, Claims 20, 23, and 24 depend from Claim 19, which has been shown to be allowable. For at least these reasons, Appellant respectfully submits that Claims 20, 23, and 24 are patentable under 35 U.S.C. § 103(a).

Issue 3: Rejection of Claim 25

The Examiner rejected Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Foudos* and *Clary*, and further in view of *Howard* (U.S. Patent Number 4,635,219). Appellant respectfully submits that there is no suggestion to combine the teachings of *Foudos*, *Clary* and *Howard* to disclose a portable check encoding device that encodes a check amount in magnetic ink and that prints the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check. Neither *Foudos* nor *Clary* disclose, teach, or suggest that an alphabetical check amount is printed on a check. In fact, *Foudos* teaches away from such a limitation by disclosing that "spaces are designated for handwritten entry by the user", the most important of which is a space for the user to hand-write the amount of the check to confirm the numerical amount imprinted on the check. (Column 4, Lines 57-64). *Clary* also teaches away from such a limitation by illustrating checks including a handwritten alphabetical check amount. (Figures 1 and 4). Furthermore, *Howard* does not disclose, teach, or suggest any portable device or a check printer that may encode a check amount on a check in magnetic ink. Again, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. There is no such suggestion to combine *Foudos*, *Clary* and *Howard*, and thus Appellant respectfully submits that the rejection of Claim 25 is improper.

Furthermore, Claim 25 depends from Claim 19, which has been shown to be allowable. For at least these reasons, Appellant respectfully submits that Claim 25 is patentable under 35 U.S.C. § 103(a).


CONCLUSION

Appellant has demonstrated that the Claims 19, 20, and 22-26 are patentable under 35 U.S.C. § 103(a). Accordingly, Appellant respectfully requests that the Board reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of Claims 19, 20, and 22-26.

The Commissioner is hereby authorized to charge the \$310.00 fee for this Appeal Brief and any fee connected with this communication to Deposit Account No. 05-0765 of Electronic Data Systems Corporation. Please credit any overpayment or charge any additional fees to Deposit Account No. 05-0765 of Electronic Data Systems Corporation. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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APPENDIX — CLAIMS PRESENTED ON APPEAL

19. A portable check encoding device, comprising:
an input device operable to receive a check amount from a user;
a display coupled to the input device and operable to display the check amount entered by the user; and
a portable check printer coupled to the input device and operable to receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check.
20. The portable check encoding device, as set forth in claim 19, further comprising a memory coupled to the check printer and operable to store and recall a list of payee names.
22. The portable check encoding device, as set forth in claim 19, wherein the check printer is operable to encode the check amount on a MICR line of the check.
23. The portable check encoding device, as set forth in claim 20, wherein the display is operable to display the list of recalled payee names and the input device is operable to receive a payee selection input from the user.
24. The portable check encoding device, as set forth in claim 23, wherein the check printer is further operable to print a selected payee name in a payee field on the check.
25. The portable check encoding device, as set forth in claim 19, wherein the check printer is further operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check.
26. The portable check encoding device, as set forth in claim 19, wherein the check received by the check printer is a blank check, the blank check including an account number but not a payee name or check amount.